

Appl. No. 09/773,241
Atty. Docket No. 8409
Amdt. dated December 22, 2005
Reply to Office Action of Sept. 22, 2005
Customer No. 27752

REMARKS

Claim Status

Claims 1 and 5-19 are pending in the present application. No additional claims fee is believed to be due.

Claim 1 has been amended to more specifically characterize the present invention. Support for the amendment can be found in the specification for example, in Figures 1-9.

It is believed these changes do not involve any introduction of new matter. Consequently, entry of these changes is believed to be in order and is respectfully requested.

Rejection Under 35 USC §103(a) Over Aledo et al.

Claims 1, 5-10, 14, and 16-19, have been rejected under 35 USC §103(a) as being unpatentable over U.S. Patent No. 4,850,988 issued to Aledo et al., hereafter "Aledo". Applicant respectfully traverses the rejection by the Office.

It is well settled that in order to establish a prima facie case of obviousness, three requirements must be met. MPEP §2143. First, there must be some suggestion or motivation, either in the cited references or in the knowledge generally available to one ordinarily skilled in the art, to modify the reference. *Id.* Second, there must be some reasonable expectation of success. *Id.* Third, the cited references must teach or suggest all of the claim limitations. *Id.*

Regarding amended claim 1, Aledo fails to teach or suggest all of the claim elements of amended claim 1. Amended claim 1 recites, in part, that the at least one elastomeric side panel includes "an inner region having at least one discontinuity... wherein the at least one discontinuity is surrounded by the inner region of the at least one elastomeric side panel." (emphasis added). In contrast, Aledo teaches a slit 17 and a slit 19 each of which extend from their side edges or side margins, respectively, inward and terminate at a circular cutout 18. (col. 3, lines 48-51; col. 4, lines 26-32). Neither of the slits 17 or 19 are surrounded by the inner region of the side panels. Therefore, Aledo does not teach or suggest all of the claim elements of amended claim 1.

Regarding claim 5, Aledo fails to teach or suggest all of the claim elements of claim 5. The Office asserts that Aledo "discloses a disposable article wherein the waist

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region has a greater width than the leg region (Figure 1 and 2 wherer the areas 15, 19, 16 are extending further than area 13)." (Office Action page 4).

It is well established that drawings and pictures can be used as prior art. MPEP §2125. However, in order for a drawing or picture to anticipate a claim, the drawing or picture must clearly show the claimed structure. *In re Mraz*, 455 F.2d 1069, 173 USPQ 25 (CCPA 1972). Additionally, where "the reference does not disclose that the drawings are to scale and is silent as to dimensions, arguments based on measurement of the drawing features are of little value." MPEP §2125 citing *Hockerson-Halberstadt, Inc. v. Avia Group Int'l*, 222 F.3d 951, 956, 55 USPQ2d 1487, 1491 (Fed. Cir. 2000).

Because the Office solely relies on the Figures of Aledo for the rejection of claim 5, Applicant asserts that the rejection is inappropriate. Accordingly, Applicant respectfully requests a withdrawal of the rejection of claim 5.

For the foregoing reasons Aledo does not teach or suggest all of the claim elements of amended claim 1 and claim 5. Therefore, Applicant asserts that amended claim 1 and claim 5 are nonobvious over Aledo. Additionally, because claims 5-10, 14, and 16-19, depend from claim 1, Applicant asserts that claims 5-10, 14, and 16-19, are also nonobvious over Aledo. Accordingly, Applicant asserts that claims 1, 5-10, 14, and 16-19, are in condition for allowance.

Rejection Under 35 USC §102(b) Over Heki et al.

Claims 1-2, 6-7, and 9-15, stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,906,008, issued to Heki et al., hereafter "Heki". Applicant respectfully traverses the rejection by the Office.

It is well settled that a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Heki fails to teach all of the claim elements of the present invention.

The Office concedes that Heki does not teach that "the waist region has an extensibility varying from about 5 g/mm to about 50 g/mm and the leg region has an extensibility varying from about 1 g/mm to about 30 g/mm", which is recited, in part, in amended claim 1. Because Heki does not teach all of the claim elements of amended claim 1, Heki cannot anticipate amended claim 1.

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However, the Office asserts that:

[I]t would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the waist and leg elasticity with specific parameters, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art.

(Office Action page 4).

However, “[a] particular parameter must first be recognized as a result-effective variable... before the determination of the optimum or workable ranges of said variable might be characterized as routine experimentation.” MPEP § 2144.05 II. B. (citing *In re Antoine*, 559 F.2d 618, 195 USPQ 6 (CCPA 1977). The specification provides that a waist region having an extensibility which is too high will exert too great a force against the wearer’s stomach, and will require too much effort to extend in the first place. (application page 18, lines 21-25) Additionally, the specification provides that a waist region having too low of an extensibility produces a holding force (force which acts about the wearer’s waist) which is too low, thereby allowing the diaper to slip off of the wearer’s waist. (application, page 18, lines 25-27).

Regarding the leg region, the specification states that an extensibility which is too high may cause the leg cuffs 32 to cut into the wearer’s thighs resulting in discomfort and red marking. (page 18, line 30 and 19, lines 1-2). If the extensibility is too low, the leg cuffs 32 might not be tensioned sufficiently to maintain complete contact of leg cuffs 32 completely around the wearer’s thigh which can result in leakage from the article. (application page 19, lines 2-5).

Applicant was unable to identify any teaching in Heki which recognizes extensibility in the waist region and/or leg regions as a result-effective variable. Heki does not appreciate the criticality of the extensibility of the waist region and the leg regions as claimed in amended claim 1. Accordingly, Applicant asserts that the claimed extensibility ranges are not mere optimization.

For the foregoing reasons, Applicant asserts the Heki does not teach or suggest all of the claim elements of amended claim 1. Accordingly, Applicant asserts that amended claim 1 is not anticipated by Heki and is nonobvious over Heki. Additionally, because claims 2, 6-7, and 9-15, depend from claim 1, Applicant asserts that they too are not

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anticipated by Heki and are nonobvious over Heki. Therefore, allowance of the pending claims is respectfully requested.

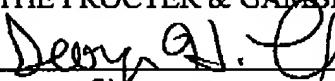
Conclusion

In light of the above remarks, it is requested that the Examiner reconsider and withdraw the rejection under 35 U.S.C. § 103(a) and § 102(b). Early and favorable action in the case is respectfully requested.

Respectfully submitted,

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By



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